

REMARKS**Paragraphs 1 and 2 of the Office Action**

Claims 1, 4, 5, 6, and 9 are rejected under 35 U.S.C. §103(a) as being
5 unpatentable over Tsai in view of Parker.

The applicant has amended claims 1 and 9 to include a hat and claim 1 has been further amended to include a coupler assembly which facilitates the angle selection as originally claimed in claims 1 and 9. It is applicant's position that the combination of Parker and Tsai would not be contemplated as the two devices are not in the same
10 classification because they contemplate completely different devices that would not generally be well suited for combination and that such a combination would not form applicant's device.

In particular, Parker describes a conventional flagpole which has an upper section that is pivotal with respect to a lower section to allow a person easy access to a top side
15 of a flag. For this reason, Parker utilizes a connector that allows a person to place the flagpole sections in only one of two orientations with respect to each other, either 180 degrees or approximately 90 degrees. At 180 degrees, the flagpole is extended straight up from the ground and at 90 degrees a top of the flagpole is positioned nearer to the ground so that a person has access to the flag. There is no reason for multiple angles to
20 be selectively chosen as other angles would not promote the benefits of Parker and because Parker does not contemplate other angles. Applicant's device, to the contrary, allows for a multitude of angles to be presented. This feature allows a person to raise or lower a flag as they choose, such as when their team is doing poorly or doing well. This feature enhances the uniqueness of applicant's device as a pure novelty item. There is
25 no reason for the applicant to lower the flag to access it as in the Parker device since applicant's entire device is always accessible. For this reason, it is believed that the limitation of fixed selective angles is not found in the prior art, and therefore applicant's device is patentably distinct from that combination.

Alternatively, even if the elements of the combination were found in the prior art,
30 their combination would not be obvious. While Tsai does show a clip for a hat, Parker is a conventional flagpole. There would be no motivation to combine a flagpole and a clip

to position on a hat as such a combination would not sit properly on a hat. Also, should such a combination be made, it would not obviousness to make the flagpole with a break therein because, as mentioned above, the purpose of applicant's motivation was based in the novelty of displaying different angles while Parker's was utilitarian in nature. The break in a flagpole mounted on a hat is simply not obvious and since Parker is not a similar device in either function or classification, one would not make the combination absent applicant's specification. Such hindsight reconstruction does not prove obviousness.

[T]he Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.' [citations omitted]

In re Fritch, 972 F.2d 1260; 23 USPQ2d 1780, 1784 (Fed. Cir. 1992), (in part quoting from In re Fine, 837 F.2d 1071, 1075; 5 USPQ2d 1596, 1600 (Fed. Cir. 1988)).

Also, the fact that modification could be made, does not prove that the modification would be made. The modification must be supported in the prior art itself and cannot come from applicant's disclosure.

The examiner finds the claimed shape would have been obvious urging that (our emphasis) "it is obvious for one skilled in the art to form each hook base of any desired shape *** since *this is within the capabilities of such a person.*" Thus, the examiner equates that which is within the capabilities of one skilled in the art with obviousness. Such is not the law. There is nothing in the statutes or the case law which makes "that which is within the capabilities of one skilled in the art" synonymous with obviousness.

The examiner provides no reason why, absent the instant disclosure, one of ordinary skill in the art would be motivated to change the shape of the coil hooks of Hancock or the German patent and we can conceive of no reason.

Ex parte Gerlach and Woerner, 212 USPQ 471 (PTO Bd. App. 1980) (emphasis in original). In the present case, Parker's device is designed for accessing a top side of a flagpole. There is no motivation within Parker, or within Tsai, to add a pole, having a break therein, to a clip which is positionable on a hat. Absent that motivation, the combination cannot be obvious.

For the above reasons, applicant believes that claims 1 and 9, and all claims depending therefrom, are in condition for allowance. The applicant respectfully requests withdrawal of the rejection.

5 **Paragraph 3 of the Office Action**

Claims 1, 7, and 10-13 are rejected under 35 U.S.C. §103(a) as being unpatentable over Tsai in view of Preziosi et al.

Claims 10-13 have been cancelled. For the reasons stated above, applicant believes that limitations found in claim 1 make claim 1 patentable over the cited art and
10 applicant respectfully requests withdrawal of the rejection.

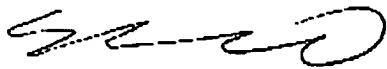
CONCLUSION

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In light of the foregoing amendments and remarks, early consideration and allowance of this application are most courteously solicited.

Respectfully submitted,

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15